LIBRARY
SUPREME COURT, U.S.

FILED
OCT 21 1957
JOHN T. FEY, Clerk

In the Supreme Court of the United States

OCTOBER TERM 1957

No. 489

LESTER F. WILSON,
Petitioner,

vs.

MUENCH-KREUZER CANDLE CO., INC.,
Respondent.

Petitioner's Reply Brief

H. CALVIN WHITE
611 Wilshire Boulevard
Los Angeles 17, California

EDWARD B. GREGG
410 Mills Building
San Francisco 4, California

Attorneys for Petitioner

TABLE OF AUTHORITIES CITED

Cases	Pages
Bobertz v. General Motors, 228 F.2d 94, C.A. 6	6
Borkland v. Pedersen, 244 F.2d 501, C.A. 7	6
Dunbar v. Meyers, 94 U.S. 187	2
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 155	5
Hartford National Bank v. E. F. Drew & Co., 237 F.2d 594, C.A. 3	6
Jungersen v. Ostby & Barton, 335 U.S. 560	6
L-O-F Glass Fibers v. Watson, 228 F.2d 40, Ct. App., Dist. Col.	6
Lyon v. Bausch & Lomb, 224 F.2d 530, C.A. 2	4, 6
Muench-Kreuzer Candle Co., Inc. v. Wilson, 246 F.2d 624, C.A. 9	Passim
Oriental Foods, Inc. v. Chun King Sales, 244 F.2d 909, C.A. 9	4, 5
R. M. Palmer Co. v. Luden's, Inc., 236 F.2d 496, C.A. 3	4
Slawson v. Grand Street R.R. Co., 107 U.S. 649	2
Zonolite Co. v. United States, 149 F. Supp. 953, Ct. of Claims	6

Constitution & Statutes	
U.S. Constitution, Article I, section 8	5
35 USC 102	5
35 USC 103	1, 3, 4, 5, 6

Rules	
Rule 19, Revised Rules of the Supreme Court of the United States	2, 3

In the Supreme Court of the United States

OCTOBER TERM 1957

No. 489

LESTER F. WILSON,
Petitioner,

vs.

MUENCH-KREUZER CANDLE CO., INC.,
Respondent.

Petitioner's Reply Brief

Respondent's Brief accomplishes one thing; it emphasizes and underscores the fact that the standard of patentable invention under 35 USC 103 is in a state of confusion and desperately needs interpretation by this Court.

Respondent's Brief raises the irrelevant, almost trivial point that Petitioner's patent "was held infringed * * * by a candle in which the dyes were placed not on the wick but on the core of the candle" (Respondent's Brief, page 2, 2nd paragraph). This point fades into insignificance beside the point made by the Court of Appeals "that Muench-Kreuzer [Respondent] took from Wilson [Petitioner] what he had" but, because of "a number of Supreme Court cases which of recent years have tightened up the standards of patentability" such taking was lawful for the reason that "what

Wilson had was in the public domain" (Court of Appeals opinion, Appendix, pages 7 and 8).

The significance of this case is not the technical point whether moving the dye away from the wick avoids infringement. It is this: When a small businessman makes an invention which is new and useful, which becomes the foundation of a small business, and which the Patent Office and a District Court find to be patentable, may he lay any store in their determinations and findings?

Respondent's Brief also contends that the invention of Petitioner's patent is not patentable because it is a mere duplication of parts (citing four cases at page 2); and it also contends that none of the grounds prescribed by Rule 19 covering reviews on certiorari are involved.

In the cited cases, mere duplication was involved; e.g., the use of two deflecting plates for a saw instead of one (*Dunbar v. Meyers*, 94 US 187); the use of two glass panes in a fare box instead of one (*Slawson v. Grand Street R.R. Co.*, 107 US 649); etc.

If mere duplication of parts were involved in the case at bar, it would not have been necessary for the Court of Appeals to review the use of aniline dyes in candles in 1871 (Appendix, page 5, the paragraph numbered 1); to discuss "the experience of children to stick a colored candle on top of one of another color, perhaps even to get successively colored drippings on a bottle" (Appendix, page 6, paragraph 2); to refer to "the old practice, particularly in candles for Christmas, of making a candle with two colors, say a white core and a red jacket" (Appendix, page 6, paragraph 3); and discuss "the pattern of (2) above, put one short colored candle after another, vary the colors, on top of each other by the use of a wick, then put on a single colored jacket" (Appendix, page 6, paragraph 3). This intricate reasoning would be unnecessary if Petitioner's invention were a mere duplication of parts.

Regarding the grounds stated in Rule 19 of the Supreme Court Rules for granting certiorari, note that the Petition demonstrates that an important question of Federal law (the meaning of 35 USC 103) has not been, but should be settled by this Court; that the meaning of 35 USC 103 has been decided differently by different courts of appeal; and that, in setting aside the findings of the District Court and substituting its own, new findings based on matters outside the record, the Court of Appeals in this case has so far departed from the accepted and basically necessary course of judicial proceedings as to call for this Court's power of supervision.

The prior art discussed in the third paragraph on page 2 of Respondent's Brief does not figure significantly in the Court of Appeals' decision. The Court of Appeals' decision was based upon the complex, ex post facto reasoning set forth in the five numbered paragraphs which appear commencing at the bottom of page 5 of the Appendix. Much of this reasoning has no foundation in the record, and Respondent does not contend otherwise. The Court of Appeals was troubled because it concedes in paragraph 5 of this reasoning that the prior art on colored flame candles (conceded by Respondent to be the most important; R. 42) did not necessarily point the way to Petitioner's invention; and because it conceded that

> "Were it not for a number of Supreme Court cases which of recent years have tightened up the standards of patentability, we might hold otherwise."

The important thing about the Court of Appeals' decision is that it assumes an entirely subjective view of the standard of patentable invention. In this case the Board of Appeals of the Patent Office (Appendix, pages 10-13) and the District Court thought they recognized patentable invention, and at the trial Respondent's counsel conceded that the most important prior art

were the flame coloring patents considered by the Board of Appeals (R. 42). The Court of Appeals sprung something new on Petitioner ("the experience of children", etc. and "the old practice, particularly in candles for Christmas", etc.) which Petitioner could have met at the trial but which took Petitioner by surprise on appeal. If these further "facts" were admissible evidence, Petitioner has had no opportunity to meet them.

This Honorable Court is earnestly requested to consider the sincere reasoning set forth in a recent opinion of the Court of Appeals for the Third Circuit, written by Judge Kalodner and concurred in by Judges Biggs, Maris, Goodrich, McLaughlin and Staley, *R. M. Palmer Co. v. Luden's, Inc.*, 236 F.2d 496, 111 USPQ1 (August 22, 1956); and this Court is also earnestly requested to contrast that opinion with the equally sincere reasoning of the Court of Appeals for the Ninth Circuit in the case at bar and in another recent case decided by the same Court, *Oriental Foods, Inc. v. Chun King Sales*, 244 F.2d 909, 113 USPQ, 404.

In the *Palmer* case, the Court of Appeals for the Third Circuit, discusses 35 USC 103 at length; notes that it was intended to stabilize the law concerning patentable invention; and expresses (at 236 F.2d 500) an agreement with Judge Learned Hand's views in *Lyon v. Bausch & Lomb*, 224 F.2d 530. The salient facts of the case, which were remarkably similar to those of the case at bar, are set forth at 236 F.2d 498 as follows:

> "The plaintiff [patentee] came to the District Court with the benefit of the presumption of validity. The defendant did not rely upon prior patents different from those considered by the Patent Office. The defendant comes to this Court with the burden of convincing us that the District Court's findings, to the extent that they are findings of fact, are clearly erroneous. United States v. U. S. Gypsum Co., 1948, 333 U. S. 364, 395, 68 S.Ct. 525, 92 L. Ed. 746."

On the record before it, and after a careful consideration of 35 USC 103, the Court of Appeals for the Third Circuit (Judge

Hastie dissenting) affirmed the District Court's holding that the patent was valid.

It is unnecessary to discuss further the opinion of the Court of Appeals of the Ninth Circuit in the case at bar which is now reported at 246 F.2d 624. It would be more profitable to consider the opinion of the same court in the *Oriental Foods* case.

In that case, at 244 F.2d 913, Judge Barnes states the extreme view that

> "The standard of invention is written into the Constitution. The Supreme Court has held that *the determination by the trial court of the question of invention need not be accorded the respect given ordinary findings of fact.*" (Emphasis added.)

Judge Barnes finds support for this extreme view in the concurring opinion of Mr. Justice Douglas in a case decided in 1950, prior to the enactment of 35 USC 103, *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 US at pages 155-156.

Now, the Constitution, Article I, Section 8 provides that the Congress shall have power

> "To promote the Progress of Science and useful Arts, by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Congress has enacted a complete body of patent statutes (Title 35 US Code) which defines patentable invention in two sections (sections 102 and 103). One section (section 103) states a negative rule, to wit that an invention is not patentable

> "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

On its face this definition presents a question of fact, and it is a definition with a century of antecedents in litigated cases.

Judge Barnes' view raises, boldly and starkly, the question whether Congress has the power to legislate concerning the standard of patentable invention, or whether it is the exclusive prerogative of the Courts to apply the Constitutional standard (to promote the Progress of Science and useful Arts).

It is respectfully submitted that the lines are clearly drawn. The case at bar, together with *Bobertz v. General Motors*, 228 F.2d 94, 99; CA 6 and *Borkland v. Pedersen*, 244 F.2d 501, 503, 504, CA 7 hold that the Patent Act of 1952 has not altered the severely high standard of invention set by recent Supreme Court cases decided prior to the Patent Act; whereas the second Circuit in *Lyon v. Bausch & Lomb*, 224 F.2d 530 and the Court of Appeals for the District of Columbia in *L-O-F Glass Fibers v. Watson*, 228 F.2d 40 hold that the older, less severe standard is adopted by 35 USC 103. The Ninth Circuit holds, in effect, that patentability is a Constitutional question to be decided exclusively by the courts; whereas the Second Circuit and District of Columbia cases adhere to the statutory standard. The Third Circuit in *Hartford National Bank v. E. F. Drew & Co.*, 237 F.2d 594, 596 and the Court of Claims in *Zonolite Co. v. United States*, 149 F. Supp. 953, 956, 957, join with the Second Circuit and the Court of Appeals for the District of Columbia in adhering to the statutory definition.

We can conclude this Reply Brief with no clearer statement of our position than a quotation from Mr. Justice Frankfurter's dissenting opinion in *Jungersen v. Ostby & Barton*, 335 US 560, 568; 93 L. Ed. 235, 240.

> "The case does, however, raise basic issues regarding the judiciary's role in our existing patent system."

To which we might add: Is the standard of patentable invention so exclusively a matter of Constitutional law that the Congress has no power to legislate; that acts of the Patent Office in issuing patents have no presumption of validity; and that the principal function of the District Courts in the trial of patent cases is to

preside at the taking of depositions, leaving to appellate courts the determination of patentable invention?

Respectfully submitted,

H. CALVIN WHITE
EDWARD B. GREGG
Attorneys for Petitioner

October 18, 1957

Certificate of Service

Pursuant to Rule 33, the above and foregoing Petitioner's Reply Brief has been served by depositing the same in a United States Post Office, with first class Air Mail postage prepaid, addressed to Lyon & Lyon, Counsel of Record for Respondent, at 811 West Seventh Street, Los Angeles 17, California, this 18th day of October, 1957.

H. CALVIN WHITE
EDWARD B. GREGG
Attorneys for Petitioner